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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/747,668	12/29/2003	Leila Song	5017	1567

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The Law Office of Stuart D. Frenkel, P.C.
Suite 330
3975 University Drive
Fairfax, VA 22030

EXAMINER

AHMED, HASAN SYED

ART UNIT PAPER NUMBER

1615

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07/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/747,668	Applicant(s) SONG ET AL.	
	Examiner Hasan S. Ahmed	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- Receipt is acknowledged of applicants' request for continued examination, which was filed on 16 April 2007.
- The 35 USC 112 rejection is withdrawn in view of the amendment filed on 16 March 2007.
- Applicant's arguments with respect to the 35 USC 103 rejection have been considered but are moot in view of the new grounds of rejection.

* * * * *

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 16 March 2007 has been entered.

* * * * *

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 51149211 A ("Saiga").

Saiga discloses a method of improving odor from natural sources (see abstract) comprising:

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- the complex metal hydride, e.g. borohydride, of instant claim 1 (see abstract);
and
- the borohydride of instant claim 4 (see abstract).

The Saiga reference discloses amines as the source of odor (see abstract), not the fish scales of instant claim 1, or the guanine of instant claim 2. However, amines are inherently the source of odor in guanines and fish scales (see instant specification, page 2, lines 17-19).

* * * * *

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8, 10, and 14-17 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 51149211 A ("Saiga") in view of JP 2003088337 A ("Hiroshi").

Saiga teaches a method of improving odor from natural sources (see above).

Saiga differs from the instant application in that it does not teach the weak acid of instant claims 5, 7, 8, and 14-17. However, the use of weak organic acids to reduce the odor of fish scale products was known in the art before the instant application was filed, as taught by Hiroshi (see paragraph 0011). Although Hiroshi does not teach the acetic acid of instant claims 8 and 17, citric acid and phosphoric acid (see paragraph 0011) are deemed to be functional equivalents of acetic acid, thus burden shifts to applicant to

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show an unexpected result with the use of acetic acid in lieu of the disclosed organic acids.

The Saiga reference also differs from the instant application in that it does not teach the fish scale derived paste of instant claims 3, 14, and 15. However, Hiroshi forms a fish scale derived paste by mixing acidic water with ground fish scales (see paragraphs 0015 and 0016).

Hiroshi explains that adding weak organic acids to fish scale derived products sharply reduces the smell of fish scales (see, e.g., paragraph 0048).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose a method of reducing the odor of fish scale derived products using a complex metal hydride and a weak acid, as taught by Saiga in view of Hiroshi. One of ordinary skill in the art at the time the invention was made would have been motivated to use such a process because it is effective in reducing the odor of fish scale derived products, as explained by Hiroshi.

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2. Claims 1, 9, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 51149211 A ("Saiga") in view of JP 2003088337 A ("Hiroshi").

Saiga teaches a method of improving odor from natural sources and Hiroshi teaches a method of reducing the odor of fish scale derived products using weak organic acids (see above).

While the prior art does not explicitly teach all the instant claimed percentages, it would have been obvious to one of ordinary skill in the art at the time the invention was

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made to determine suitable percentages through routine or manipulative experimentation to obtain the best possible results, as these are variable parameters attainable within the art.

Moreover, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456; 105 USPQ 233, 235 (CCPA 1955). Applicants have not demonstrated any unexpected or unusual results, which accrue from the instant percentage ranges.

*

3. Claims 1 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 51149211 A ("Saiga") in view of JP 2003088337 A ("Hiroshi"), further in view of U.S. Patent No. 4,486,334 ("Horiuchi").

Saiga teaches a method of improving odor from natural sources and Hiroshi teaches a method of reducing the odor of fish scale derived products using weak organic acids (see above).

Saiga and Hiroshi differ from the instant application in that they do not teach a cosmetic formulation. However, fish scale derived cosmetic formulations were known in the art before the instant application was filed, as explained by Horiuchi (see col. 1, lines 11-31).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to disclose a cosmetic formulation derived from fish scales, as taught by Horiuchi. One of ordinary skill in the art at the time the invention was made would have been motivated to make such a formulation because it improves attractiveness of the cosmetic formulation and increases its commercial value, as explained by Horiuchi (see col. 1, lines 14-16).

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Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hasan S. Ahmed whose telephone number is 571-272-4792. The examiner can normally be reached on 9am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


HUMERA N. SHEIKH
PRIMARY EXAMINER